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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

HO, ALLEN C

ART UNIT PAPER NUMBER

2882

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,753

Applicant(s)

BRATSLAVSKY ET AL.

Examiner

Allen C. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 5, 6, 9, 10, 16, and 17 are objected to because of the following informalities:

One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925). It is improper to use the term "comprising" instead of "consisting of." Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Brooks (U. S. Patent No. 5,001,738).

Brooks disclosed a system for dental x-ray examinations, comprising: an image sensor (11); a sheath covering the image sensor (column 3, lines 49-52); and a holder (10) having an adhesive coating (21) and bonded to the sheath by the adhesive coating.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 8, 9, 11, 12, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (U. S. Patent No. 5,001,738).

Brooks disclosed a system for dental x-ray examinations, comprising: an image sensor (11); a sheath made of paper or plastic covering the image sensor (column 3, lines 49-52); and a holder (10) having an adhesive coating (21) and bonded to the image sensor by the adhesive coating.

However, Brooks did not teach that the system comprises: (1) the adhesive coating is on the sheath; and (2) the holder is removably bonded to the image receptor by the adhesive coating.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to: (1) Put the adhesive coating on the sheath instead of the holder, since a person would recognize that putting the adhesive coating on the sheath is equivalent to putting the adhesive coating on the holder, as long as the sheath and the holder are bonded to each other. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to choose from among the known equivalents based solely on design choice absent any showing of criticality; the lack of criticality is demonstrated by applicant's claiming of a plurality of equivalent designs. (2) Bond the holder removably to the image receptor, since a

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person would be motivated to dispose of the holder before preparing the image receptor for the next patient.

6. Claims 2, 3, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (U. S. Patent No. 5,001,738) as applied to claims 1, 7, and 11 above, and further in view of Carroll *et al.* (U. S. Patent No. 6,320,934 B1).

Brooks disclosed a system for dental x-ray examinations, comprising an image sensor (11).

However, Brooks did not teach that the image sensor comprises a charge-coupled device (CCD) or a CMOS active pixel sensor array.

Carroll *et al.* disclosed that electronic image sensors comprising CCD or CMOS active pixel sensor arrays have been adapted to dental x-ray imaging (column 1, lines 59-63).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ an electronic image sensor that comprises CCD or CMOS active pixel sensor arrays, since a person would be motivated to save time by using an electronic image sensor instead of an x-ray film which requires extended time for film processing.

7. Claims 6, 10, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks (U. S. Patent No. 5,001,738) as applied to claims 1, 7, and 11 above.

Brooks disclosed a system for dental x-ray examinations, comprising: an image sensor (11); a sheath made of paper or plastic covering the image sensor (column 3, lines 49-52); and a holder (10) having an adhesive coating (21) and bonded to the image sensor by the adhesive coating.

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However, Brooks did not teach that the adhesive is selected from the group consisting of tape, epoxy, hot melt, and sealant.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use an adhesive selected from the group consisting of tape, epoxy, hot melt, and sealant, since a person would be motivated to employ an adhesive that is capable of removably bonding the holder and the image sensor as long as it is safe to the patient. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to choose from among the known equivalents based solely on design choice absent any showing of criticality; the lack of criticality is demonstrated by applicant's claiming of a plurality of equivalent adhesive.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (1) Bacchetta *et al.* (U. S. Patent No. 6,382,831 B1) describe an intraoral radiographic film packet holder.
- (2) Welp (U. S. Patent No. 6,216,870 B1) describe sheath for a dental x-ray film.
- (3) Tanaka (U. S. Patent No. 5,450,465) describes a method for enclosing dental x-ray film pack.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen C. Ho whose telephone number is (703) 308-6189. The examiner can normally be reached on Monday - Friday from 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached at (703) 305-3492. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.

Allen C. Ho
Examiner
Art Unit 2882

ACH
January 3, 2003

